U.S. Patent Application No. 09/833,202
Request for Reconsideration dated November 3, 2005
Response to Final Office Action dated August 4, 2005

REMARKS

Reconsideration and continued examination of the above-identified application are respectfully requested.

Statement of Substance of Interview

The applicant would like to thank Examiner Alejandro for the courtesy of a telephone interview on October 5, 2005 with applicant's representative, Ralph Webb, Reg. No. 33,047. During the interview, the provisional double patenting rejection over co-pending U.S. Patent Application No. 10/112,689 and the obviousness rejections over Yu et al. (U.S. Patent No. 6,399,202) in view of Datz et al. (U.S. Application Publication No. 2005/0118493) and over Yu et al. in view of the publication Amine et al., "New Process for Loading Highly Active Platinum on Carbon Black Surface for Application in Polymer Electrolyte Fuel Cell," Ann. Chim. Sci. Mat., Vol. 23, No. 1-2, January 2, 1998, pp. 331-335 were discussed. It was discussed with the Examiner that both of the rejections having Yu, et al. as the primary reference can be overcome under 35 U.S.C. 103(c) by the submission of a statement showing common ownership between the present application and Yu, et al. at the time the present invention was made. It was further discussed that the provisional double patenting rejection over claims 1, 3 - 8, 10 and 14 of co-pending U.S. Patent Application No. 10/112,689 would then become the only outstanding issue in the application and that in such a circumstance, it is appropriate for the Examiner to withdrawn the provisional double patenting rejection and allow the application to issue. It was further discussed with the Examiner that claims 1, 3 - 8, 10 and 14 of co-pending U.S. Patent Application No. 10/112,689 are currently inactive and therefore not likely to be contained in an

issued patent before the current application issues.

Rejection of claims 1, 3 - 8, 10, and 14 under the judicially created doctrine of obviousness-type double patenting over claims 1, 3 - 8, 10, and 14 of the co-pending U.S. Patent Application No. 10/112,689

At page 3 of the Office Action, the Examiner provisionally rejected claims 1, 3 - 8, 10, and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 - 8, 10, and 14 of the co-pending U.S. Patent Application No. 10/112,689 (U.S. Patent Application Publication No. 2003/0017379) by Cabot Corporation. For the following reasons, this provisional rejection should be withdrawn.

In view of the argument and statement of common ownership presented below to overcome the remaining rejections in the application by virtue of the provisions of 35 U.S.C. §103(c), the provisional double patenting rejection becomes the only outstanding issue in the present application. Moreover, it is not likely that co-pending U.S. Patent Application No. 10/112,689 will be put into condition for allowance containing claims 1, 3-8, 10 and 14 before the present application is in condition for allowance, since, in the co-pending application, claim 14 has been canceled and claims 1, 3 - 8 and 10 have been withdrawn from consideration. Therefore, none of claims 1, 3 - 8, 10 and 14 are currently active in U.S. Patent Application No. 10/112,689. Under such circumstances, M.P.E.P Section 804.I.B authorizes the Examiner to withdraw the provisional double patenting rejection in the application in which the remaining rejections have been overcome and permit the application to issue as a patent. The provisional double patenting rejection in the other application will be converted into a double patenting

rejection at the time the current application issues as a patent.

Accordingly, upon the withdrawal of the remaining rejections in this application, the provisional double patenting rejection should be withdrawn.

Rejection of claims 1, 3 - 8, 10, 14, 17 – 22, and 24 - 25 under 35 U.S.C. §103(a) over Yu et al. in view of Datz et al.

At page 5 of the Office Action, the Examiner rejected claims 1, 3 - 8, 10, 14, 17 – 22, and 24 - 25 under 35 U.S.C. §103(a) over Yu et al. (U.S. Patent No. 6,399,202) in view of Datz et al. (U.S. Application Publication No. 2005/0118493). For the following reasons, this rejection is respectfully traversed.

The rejection made by the Examiner is an obviousness rejection under 35 U.S.C. §103(a) in which the primary reference, Yu, et al. can qualify as prior art against the present application only under the provisions of U.S.C. §102(e), (f), or (g) (see the previous Office Action of March 31, 2003). Accordingly, the reference may be disqualified under 35 U.S.C. §103(c) in view of common ownership of the present application and the applied reference. The applicant respectfully submits that Yu et al. is disqualified as prior art to support an obviousness rejection in view of the fact that the present application and Yu et al. were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Sufficient evidence to establish common ownership at the time the invention was made is provided by the following Statement of Common Ownership by the undersigned, an attorney of record in the application:

STATEMENT OF COMMON OWNERSHIP

U.S. Patent Application No. 09/833,202 and U.S. Patent No. 6,399,202 were, at the time the invention of U.S. Patent Application No. 09/833,202 was made, owned by, or subject to an obligation of assignment to, Cabot Corporation.

Although the above is sufficient by itself to require withdrawal of the rejection, the applicant further notes that the Examiner did not establish that the alleged teachings of the secondary reference, Datz et al., are prior art against the claims of the present application. Datz et al. is a published U.S. patent application having a filing date of July 30, 2004, which is after the filing date of the present application. The Datz et al. application is a continuation-in-part of a U.S. application filed on February 26, 2001, which application was a continuation of an international application filed before August 20, 1999 (therefore, the filing date of the international application may not be used). By definition, a continuation-in-part application contains subject matter that was not present in the earlier application. (M.P.E.P. § 201.08) The Examiner did not establish that the subject matter allegedly disclosed in Datz et al. and relied on by the Examiner to support the rejection was present in the earlier continuation-in-part application and not newly added to the application as filed on July 30, 2004.

Accordingly, this rejection should be withdrawn.

Rejection of claims 17 - 19 and 21 - 25 under 35 U.S.C. §103(a) over Yu et al. in view of Amine et al.

At page 11 of the Office Action, the Examiner rejected claims 17 - 19 and 21 - 25 under

35 U.S.C. §103(a) over Yu et al. (U.S. Patent No. 6,399,202) in view of the publication Amine et al., "New Process for Loading Highly Active Platinum on Carbon Black Surface for Application in Polymer Electrolyte Fuel Cell," Ann. Chim. Sci. Mat., Vol. 23, No. 1-2, January 2, 1998, pp. 331-335 ("Amine et al.). For the following reasons, this rejection is respectfully traversed.

As noted above, Yu et al. is disqualified under 35 U.S.C. §103(c) as prior art to support an obviousness rejection in view of the fact that the present application and Yu et al. were, at the time the present invention was made, owned by the same person or subject to an obligation of assignment to the same person, as evidenced by the above Statement of Common Ownership.

Therefore, this rejection should be withdrawn.

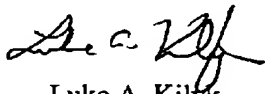
If there are any questions or concerns, the Examiner is encouraged to contact the undersigned by telephone.

CONCLUSION

In view of the foregoing remarks, the applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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